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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

ATT030073

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Application Number

10/611,453

Filed

06/30/2003

First Named Inventor

Gray

Art Unit

2623

Examiner

Salce, Jason P

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.

Registration number

36,693

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

/Bruce E. Stuckman Reg. No. 36,693/

Signature

Bruce E. Stuckman

Typed or printed name

512-241-8444

Telephone number

10/29/2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.



\*Total of

1

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**PATENT APPLICATION  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Applicant:** James Gray

**Serial No:** 10/611,453

**Filing Date:** 6/30/2003

**Confirm No:** 1614

**Examiner:** Salce, Jason P.

**Art Group:** 2623

**Docket No:** ATT030073

**Title:** SYSTEM AND METHOD FOR ENHANCED HOT KET FUNCTIONALITY

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Date: 10/29/2008

Honorable Commissioner of  
Patents and Trademarks,  
Alexandria, Virginia 22313

**PREAPPEAL BRIEF REQUEST FOR REVIEW**

1. In Office Action mailed on 9/23/2008 regarding the above-captioned patent application, the Examiner rejected claims 23-29 under 35 USC § 101 as being directed to non-statutory subject matter; claims 14-17, 19, 76-79 and 81 under 35 USC § 102 (e) as being anticipated by Blackketter (U.S. Patent No. 7,237,253); claims 18, 49 and 80 under 35 USC § 103 (a) as being unpatentable over Blackketter (U.S. Patent No. 7,237,253) and claims 45-48 and 50 under 35 USC § 103 (a) as being unpatentable over Blackketter (U.S. Patent No. 7,237,253) in view of Field (U.S. Patent No. 6,018,764). Applicant respectfully believes that there is a clear deficiency in the prima facie case in support of this rejection and requests review of the allowability of claims 14-19, 45-50 and 76-81 pursuant to the Pre-Appeal Brief Pilot Program.

2. As discussed above, the Examiner rejected claims 23-29 under 35 USC § 101 as being directed to non-statutory subject matter. The applicant respectfully submits there is a clear error in the examiner's rejection. Claims 23-29 were cancelled in a prior response. Applicant respectfully requests that this basis for rejection be withdrawn.

3. As discussed above, claim 14 was also rejected under 35 USC § 102 (e) as being anticipated by Blackketter (U.S. Patent No. 7,237,253). Claim 14 recites in part:

“determining, at the user device and independent of any request by a user of the user device for the alternate content, whether the indicator signal is relevant to a user viewing original content provided by the interactive television service provider’s network; and

responsive to determining the indicator signal is relevant to the user, displaying on a screen an indication that the indicator signal has been received, the indication corresponding to the data representing the indicator form,

wherein subject matter of the alternate content is different from subject matter of the original content; and

wherein the determining is based at least in part on one of the following: a channel providing the original content presently being viewed by the user; choice of content type selected by the user in viewing the original content; and genre of the original content selected by the user.” [emphasis added]

In setting forth the basis for the rejection, the Examiner points to steps 302-310 in Figure 9 for determining an interactive mode based on the received television program. While Blackketter does determine whether an interactive mode is available for a particular channel, Blackketter specifically does not determine whether an indicator signal is relevant to a user, based on the channel being viewed by the user. In particular, Blackketter has no way of knowing whether in indicator signal is relevant to the user or not. Blackketter, merely displays an indicator, whenever the interactive mode is available – and without regard as to whether the interactive mode is relevant or not.

For these reasons, claim 14 and claims 15-19 that depend therefrom are patentably distinct from the prior art. Further, while claim 18 was also rejected based on the Blackketter in combination with Official Notice. The Official notice relied upon by the Examiner does not correct the deficiency in Blackketter discussed above.

3. As discussed above, claim 76 was rejected under 35 USC § 102 (e) as being anticipated by Blackketter (U.S. Patent No. 7,237,253). Claim 76 recites in part:

“determining, at the user device, and independent of any request by a user of the user device for the alternate content, whether the indicator

signal is relevant to a user viewing original content provided by the interactive television service provider's network; and

responsive to determining the indicator signal is relevant to the user, display on a screen an indication that the indicator signal has been received, the indication corresponding to the data representing the indicator form;

wherein subject matter of the alternate content is different from subject matter of the original content; and

wherein the determining is based at least in part on one of the following: a channel providing the original content presently being viewed by the user; choice of content type selected by the user in viewing the original content; and genre of the original content selected by the user." [emphasis added]

As discussed in conjunction with Claim 14, Blackketter specifically does not determine whether an indicator signal is relevant to a user, based on the channel being viewed by the user. In particular, Blackketter has no way of knowing whether in indicator signal is relevant to the user or not. Blackketter, merely displays an indicator, whenever the interactive mode is available – and without regard as to whether the interactive mode is relevant or not.

For these reasons, claim 76 and claims 77-81 that depend therefrom are patentably distinct from the prior art. Further, while claim 80 was also rejected based on the Blackketter in combination with Official Notice. The Official notice relied upon by the Examiner does not correct the deficiency in Blackketter discussed above.

5. As discussed above, claim 45 was rejected claims 45-48 and 50 under 35 USC § 103 (a) as being unpatentable over Blackketter (U.S. Patent No. 7,237,253) in view of Field (U.S. Patent No. 6,018,764). Claim 45 recites in part:

“a processor coupled to the demultiplexor portion to determine whether the indicator signal is relevant to a user viewing original content over a channel provided by the interactive television service provider's network, and responsive to determining the indicator signal is relevant to the user, displaying on a screen an indication that the indicator signal has

been received, the indication corresponding to the data representing the indicator form;

wherein the determining is independent of any request by the user for the alternate content;

wherein subject matter of the alternate content is different from subject matter of the original content; and

wherein the determining is based at least in part on one of the following: the channel providing the original content presently being viewed by the user; choice of content type selected by the user in viewing the original content; and genre of the original content selected by the user.” [emphasis added]

As discussed in conjunction with Claim 14, Blackketter specifically does not determine whether an indicator signal is relevant to a user, based on the channel being viewed by the user. In particular, Blackketter has no way of knowing whether in indicator signal is relevant to the user or not. Blackketter, merely displays an indicator, whenever the interactive mode is available – and without regard as to whether the interactive mode is relevant or not. While Blackketter was further combined with Field, Field does not correct the deficiency in Blackketter discussed above.

For these reasons, claim 45 and claims 46-50 that depend therefrom are patentably distinct from the prior art. Further, while claim 49 was also rejected based on the Blackketter in combination with Official Notice. The Official Notice relied upon by the Examiner also does not correct the deficiency in Blackketter discussed above.

The Examiner is invited to contact the undersigned by telephone or facsimile if the Examiner believes that such a communication would advance the prosecution of the present invention.

RESPECTFULLY SUBMITTED,

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